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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92059244
Party	Plaintiff Garan Services Corp.
Correspondence Address	ROBERT L EPSTEIN EPSTEIN DRANGEL LLP 60 EAST 42ND STREET, SUITE 2410 NEW YORK, NY 10165 UNITED STATES mail@ipcounselors.com
Submission	Opposition/Response to Motion
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Date	04/10/2015
Attachments	Opposition to Motion to Reopen 92059244.pdf(517622 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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GARAN SERVICES CORP.	:	
	:	
Petitioner,	:	
	:	
v.	:	Cancellation No. 92059244
	:	Registration No.4284412
	:	
	:	
NEWMAN	:	
	:	
	:	
Registrant.	:	
	X	

**PETITIONER'S RESPONSE TO RESPONDENTS MOTION TO
REOPEN THE TERM TO RESPOND TO SERVICE BY PUBLICATION**

Petitioner, Garan Services Corp., hereby opposes Registrant's Motion to Reopen the Term to Respond to Service by Publication.

Registrant's motion is based upon the totally unsupported assertion that Registrant's failure to timely appear in this proceeding was based on excusable neglect. The record in this case clearly indicates otherwise and Registrant's motion fails to include any evidence to contradict the record of Registrant's long and inexcusable neglect of this matter. The motion provides no support for any conclusion other than that Registrant was notified of the filing of the petition by the Board nine months before its counsel filed this untimely motion.

The Board Notified Registrant of the Filing of the Petition on May 23, 2014

The record unequivocally demonstrates that on May 23, 2014 the Board mailed Registrant notification of the filing of the petition to cancel its Registration No. 4284412, see Exhibit A hereto. That notification by the Board indicates that it was sent to Registrant's correct address. There is nothing in the record which indicates that the notification of Exhibit A was returned as undeliverable.

The undersigned is advised that it is the standard practice of the Board that all institutional orders which include the notice of the filing of a petition and the trial dates be automatically sent to the address of record of the Registrant. The document of Exhibit A is irrefutable evidence that notification of this proceeding was mailed by the Board to Registrant's correct address of record on May 23, 2014, in accordance with its standard practice.

Significantly, Registrant does not deny that it received the Board's May 23, 2014 notification of the filing the petition and institution of the proceeding.

It is worth noting that the Board, in its December 8, 2014 order suspending the proceeding pending service by publication, stated that a search was conducted and the Board had been unable to locate a different address for Registrant, other than the address to which its May 23, 2014 notice had been mailed, see Exhibit B.

Service by publication occurred on February 10, 2015. In its motion, Registrant does not deny that it was aware of the service by publication within the thirty day period ending March 12, 2015 provided for Registrant to enter an appearance in this proceeding. It cannot be debated that Registrant did not enter an appearance with the allotted time.

For the first time, on March 20, 2015, a power of attorney for Registrant's counsel was

filed and Registrant's counsel was appointed as Registrant's Domestic representative with regard to the registration at issue in this preceding. The instant motion to reopen was filed March 23, 2015.

The Motion Fails to Provide Any Proof by Registrant's Declaration or Affidavit

In the motion, buried in a footnote on page 2, Registrant's counsel admits that she was aware that the Board's institution order was mailed to Registrant's address of record. Counsel does not say when she became aware of the order.

Counsel goes on to state that "It cannot be determined if Respondent received the document..." Registrant's counsel fails to explain why it cannot be determined if the order was received by the Registrant. Wouldn't the Registrant know if it received the order? The fact that the Registrant has not provided a declaration or affidavit to address this issue, the key issue in this motion, speaks volumes. Moreover, counsel is silent as to if and when other members of her firm became aware of the Board's order.

After not being able to determine if Registrant received the Board's correctly addressed institutional order, Registrant's counsel goes on to state: "...and if it did whether it understood the document as it is a French company..." Again, no declaration, affidavit or proof of any kind by Registrant is provided to support a conclusion that Registrant did not understand the document which the Board mailed to it.

Registrant's counsel continues to say that Registrant "should not be presumed to know and understand the rules of the TTAB." It is a well decided principle that ignorance of the law is no excuse, even for a French company. Moreover, it is difficult to understand why a French

company, receiving an official legal document in the English language from an agency of the U.S. government, would ignore same. Was there not a single individual employed by or associated with the Registrant who was able to read English?

Should it be presumed that the Registrant was unable to obtain a translation of the order into French? Even if there was not a single individual employed by or associated with the Registrant who was able to read English, in this day and age, a translation of an English language document can be obtained on the Internet, immediately and for free, by simply clicking a few buttons on an Internet connected computer. Here again, no declaration or affidavit from the Registrant is provided to support a conclusion that Registrant did not understand the Board's order because it was in English or could not obtain a translation of such order.

The *Pioneer* Factors Do Not Weigh in Favor of Registrant

Registrant cites *Pioneer Investment Services Company v Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993) as setting forth the factors for finding "excusable neglect" as the equity of the situation, the danger of prejudice to Petitioner, the length of the delay, the reason for the delay, and whether the movant acted in good faith. It is clear from *Pumpkin Ltd. v Seed Corps.*, 43 U.S.P.Q. 2d 1582 (T.T.A.B. 1997) that the length of time of the delay is the most important factor in this determination.

In *Pumpkin*, at page 1588, the Board noted that "The Board's interest in deterring such sloppy practice weighs heavily against a finding of excusable neglect under the second *Pioneer* factor.". In *Vital Pharmaceuticals, Inc. v Conrad J. Kronholm, Jr.*, 99 U.S. P. Q. 2d 1708, 2011 WL 3381379 (T.T.A.B.) the Board determined that a seven month delay with inadequate reason

failed to show excusable neglect for reopening testimony period. Here, the delay was nine months, from the date of the Board's May 23, 2014 order to March 23, 2015, the date that the present motion was filed. No proof to support an adequate reason for the nine month delay is provided.

Clearly that nine month delay has had a substantial impact on this proceeding and has prejudiced Petitioner by being prevented from moving forward with its commercial plans to use the mark of the registration at issue.

With respect to Registrant's good faith, Petitioner can and does question Registrant's good faith. Registrant ignored the Board's institutional order mailed to its correct address. After receiving the order it did not act on it or engage counsel until March 20, 2015. Further, Registrant did not provide any proof by way of declaration or affidavit which could support any reasonable excuse for its nine month inaction.

Registrant's motion should be Denied

Registrant's motion, filed nine months after the Board mailed its institutional order to Registrant's correct address, is untimely. Further, the motion includes only attorney argument. It provides no proof for the claim that Registrant did not receive the Board's order which was mailed to the correct address or that it received the order but did not understand it or that it could not translate the order. Likewise, the motion lacks the declaration or affidavit of Registrant's counsel. Registrant's motion includes no proof at all of anything.

The motion should be denied.

Dated: April 10, 2015

EPSTEIN DRANGEL LLP

By: 

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William C. Wright

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Attorneys for Petitioner

Garan Services Corp.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Response to Respondent's Motion to Reopen the Term was served by First Class Mail, with sufficient postage prepaid, on this 10th day of April 2015, upon the Domestic Representative:

JULIE B. SEYLER

ABELMAN FRAYNE & SCHWAB

666 THIRD AVENUE

NY, NEW YORK 10017

UNITED STATES

BY:


Robert L. Epstein

Exhibit A

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: May 23, 2014

Cancellation No. 92059244
Registration No. 4284412

NEWMAN
25-27 RUE DU MAIL
F-75002 PARIS FRANCE

Garan Services Corp.

v.

Newman

ROBERT L EPSTEIN
EPSTEIN DRANGEL LLP
60 EAST 42ND STREET
SUITE 2410
NEW YORK NY 10165 UNITED STATES

Lalita Greer, Paralegal Specialist:

A petition to cancel the above-identified registration, as to Class 25 only, has been filed. A service copy of the petition for cancellation was forwarded to registrant (defendant) by the petitioner (plaintiff). An electronic version of the petition for cancellation is viewable in the electronic file for this proceeding via the Board's TTABVUE system: <http://ttabvue.uspto.gov/ttabvue/>.

The Board acknowledges that petitioner included proof that it forwarded a service copy of its petition to registrant. Specifically, the proof of service indicates that petitioner sent that service copy to an address that apparently petitioner has reason to believe is the current address for the registrant, however it is not of record with this Office. As provided in amended Trademark Rule 2.111(a), a petitioner must include "proof of service on the owner of record for the registration, or the owner's domestic representative of record, at the correspondence address of record of the Office." The reference in the rule to correspondence address is a reference to the address for the owner of the registration or the domestic representative, if one has been appointed. A courtesy copy may be sent to an address that the petitioner has reason to believe is current, but does not substitute for service on the registrant at the address on record with the USPTO.

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations ("Trademark Rules"). These rules may be viewed at the

USPTO's trademarks page: <http://www.uspto.gov/trademarks/index.jsp>. The Board's main webpage (<http://www.uspto.gov/trademarks/process/appeal/index.jsp>) includes information on amendments to the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to the Board's manual of procedure (the TBMP).

Plaintiff must notify the Board when service has been ineffective, within 10 days of the date of receipt of a returned service copy or the date on which plaintiff learns that service has been ineffective. Plaintiff has no subsequent duty to investigate the defendant's whereabouts, but if plaintiff by its own voluntary investigation or through any other means discovers a newer correspondence address for the defendant, then such address must be provided to the Board. Likewise, if by voluntary investigation or other means the plaintiff discovers information indicating that a different party may have an interest in defending the case; such information must be provided to the Board. The Board will then effect service, by publication in the Official Gazette if necessary. See Trademark Rule 2.118. In circumstances involving ineffective service or return of defendant's copy of the Board's institution order, the Board may issue an order noting the proper defendant and address to be used for serving that party.

Defendant's ANSWER IS DUE FORTY DAYS after the mailing date of this order. (See Patent and Trademark Rule 1.7 for expiration of this or any deadline falling on a Saturday, Sunday or federal holiday.) Other deadlines the parties must docket or calendar are either set forth below (if you are reading a mailed paper copy of this order) or are included in the electronic copy of this institution order viewable in the Board's TTABVue system at the following web address: <http://ttabvue.uspto.gov/ttabvue/>.

Defendant's answer and any other filing made by any party must include proof of service. See Trademark Rule 2.119. If they agree to, the parties may utilize electronic means, e.g., e-mail or fax, during the proceeding for forwarding of service copies. See Trademark Rule 2.119(b)(6).

The parties also are referred in particular to Trademark Rule 2.126, which pertains to the form of submissions. Paper submissions, including but not limited to exhibits and transcripts of depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Time to Answer	7/2/2014
Deadline for Discovery Conference	8/1/2014
Discovery Opens	8/1/2014
Initial Disclosures Due	8/31/2014
Expert Disclosures Due	12/29/2014
Discovery Closes	1/28/2015
Plaintiff's Pretrial Disclosures	3/14/2015
Plaintiff's 30-day Trial Period Ends	4/28/2015
Defendant's Pretrial Disclosures	5/13/2015
Defendant's 30-day Trial Period Ends	6/27/2015
Plaintiff's Rebuttal Disclosures	7/12/2015
Plaintiff's 15-day Rebuttal Period Ends	8/11/2015

As noted in the schedule of dates for this case, the parties are required to have a conference to discuss: (1) the nature of and basis for their respective claims and defenses, (2) the possibility of settling the case or at least narrowing the scope of claims or defenses, and (3) arrangements relating to disclosures, discovery and introduction of evidence at trial, should the parties not agree to settle the case. See Trademark Rule 2.120(a)(2). Discussion of the first two of these three subjects should include a discussion of whether the parties wish to seek mediation, arbitration or some other means for resolving their dispute. Discussion of the third subject should include a discussion of whether the Board's Accelerated Case Resolution (ACR) process may be a more efficient and economical means of trying the involved claims and defenses. Information on the ACR process is available at the Board's main webpage. Finally, if the parties choose to proceed with the disclosure, discovery and trial procedures that govern this case and which are set out in the Trademark Rules and Federal Rules of Civil Procedure, then they must discuss whether to alter or amend any such procedures, and whether to alter or amend the Standard Protective Order (further discussed below). Discussion of alterations or amendments of otherwise prescribed procedures can include discussion of limitations on disclosures or discovery, willingness to enter into stipulations of fact, and willingness to enter into stipulations regarding more efficient options for introducing at trial information or material obtained through disclosures or discovery.

The parties are required to conference in person, by telephone, or by any other means on which they may agree. A Board interlocutory attorney or administrative trademark judge will participate in the conference, upon request of any party, provided that such participation is requested no later than ten (10) days prior to the deadline for the conference. See Trademark Rule 2.120(a)(2). The request for Board participation must be made through the Electronic System for Trademark Trials and Appeals (ESTTA) or by telephone call to the interlocutory attorney assigned to the case, whose name can be found by referencing the TTABVue record for this case at <http://ttabvue.uspto.gov/ttabvue/>. The parties should contact the assigned interlocutory attorney or file a request for Board participation through ESTTA only after the parties have agreed on possible dates and times for their conference. Subsequent participation of a Board attorney or judge in the conference will be by telephone and the parties shall place the call at the agreed date and time, in the

absence of other arrangements made with the assigned interlocutory attorney.

The Board's Standard Protective Order is applicable to this case, but the parties may agree to supplement that standard order or substitute a protective agreement of their choosing, subject to approval by the Board. The standard order is available for viewing at:

<http://www.uspto.gov/trademarks/process/appeal/guidelines/stdnagmnt.jsp>. Any party without access to the web may request a hard copy of the standard order from the Board. The standard order does not automatically protect a party's confidential information and its provisions must be utilized as needed by the parties. See Trademark Rule 2.116(g).

Information about the discovery phase of the Board proceeding is available in chapter 400 of the TBMP. By virtue of amendments to the Trademark Rules effective November 1, 2007, the initial disclosures and expert disclosures scheduled during the discovery phase are required only in cases commenced on or after that date. The TBMP has not yet been amended to include information on these disclosures and the parties are referred to the August 1, 2007 Notice of Final Rulemaking (72 Fed. Reg. 42242) posted on the Board's webpage. The deadlines for pretrial disclosures included in the trial phase of the schedule for this case also resulted from the referenced amendments to the Trademark Rules, and also are discussed in the Notice of Final Rulemaking.

The parties must note that the Board allows them to utilize telephone conferences to discuss or resolve a wide range of interlocutory matters that may arise during this case. In addition, the assigned interlocutory attorney has discretion to require the parties to participate in a telephone conference to resolve matters of concern to the Board. See TBMP § 502.06(a) (2d ed. rev. 2004).

The TBMP includes information on the introduction of evidence during the trial phase of the case, including by notice of reliance and by taking of testimony from witnesses. See TBMP §§ 703 and 704. Any notice of reliance must be filed during the filing party's assigned testimony period, with a copy served on all other parties. Any testimony of a witness must be both noticed and taken during the party's testimony period. A party that has taken testimony must serve on any adverse party a copy of the transcript of such testimony, together with copies of any exhibits introduced during the testimony, within thirty (30) days after the completion of the testimony deposition. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing after briefing is not required but will be scheduled upon request of any party, as provided by Trademark Rule 2.129.

If the parties to this proceeding are (or during the pendency of this proceeding become) parties in another Board proceeding or a civil action involving related marks or other issues of law or fact which overlap with this case, they shall notify the Board immediately, so that the Board can consider whether consolidation or suspension of proceedings is appropriate.

ESTTA NOTE: For faster handling of all papers the parties need to file with the Board, the Board strongly encourages use of electronic filing

Cancellation No. 92059244

through the Electronic System for Trademark Trials and Appeals (ESTTA). Various electronic filing forms, some of which may be used as is, and others which may require attachments, are available at <http://estta.uspto.gov>.

Exhibit B

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: December 8, 2014

Cancellation No. 92059244

Garan Services Corp.

v.

Newman

Rochelle Adams, Paralegal Specialist:

The notice of ineffective service dated August 11, 2014 is noted. The Board has conducted a search and have been unable to locate a different address for the registrant. The Board's July 19, 2014 notice of default is hereby vacated.

Accordingly, it will be necessary before proceeding herein to give notice by publication in the Official Gazette, as prescribed by Trademark Rule 2.118.

Pending such publication, proceedings herein are suspended.

cc:

Robert L. Epstein
Epstein Drangel LLP
60 East 42nd Street Suite 2410
New York, NY 10165